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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,088	07/12/2001	Peter K. Malkin	YOR9-2001-0331 (8728-517)	1876

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/904,088

Applicant(s)

MALKIN ET AL

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-4, 7-9 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Zweben et al. (US 2002/0169686).**

Zweben et al. teach a method and system for using portable devices to provide merchandising information, comprising:

**Claim 1.**

receiving an electronic service request including a product identifier and a customer query from a customer within a sales environment [0041];

retrieving data corresponding to the product identifier from a product database [0041];

determining a portion of the data relating to the customer query [0041];

delivering an electronic reply to the customer including the portion of the data corresponding to the product identifier and relating to the customer query [0041].

**Claim 2.** Said method and system, further comprising the step of issuing the customer a mobile device, wherein the mobile device issues the electronic service request [0039].

**Claim 3.** Said method and system, further comprising the step of issuing the customer a mobile device, wherein the mobile device determines the product identifier [0039].

**Claim 4.** Said method and system, further comprising the step of issuing the customer a mobile device and a corresponding customer identification (loyalty card) [0039].

**Claim 7.** Said method and system, further comprising the step of storing the service request in a customer database corresponding to the customer identification [0039]; [0042].

**Claim 8.** Said method and system, wherein the product identifier is determined according to one of a product radio frequency identification tag, a bar code scan, a verbal description provided by the customer, a digital photo, and an alphanumeric identification [0043].

**Claim 9.** See claim 1 and claim 2.

**Claim 16.** See claim 8.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. in view of Lefkowitz (US 2002/0188501).**

**Claim 5.** Zweben et al. teach said method and system, wherein the loyalty card (customer identification) is issued to the customer [0039].

However, Zweben et al. do not specifically teach that said identification is persistent.

Lefkowitz teaches a method and system for providing rebates based on purchases made at participating retailer locations, wherein a customer is provided with a customer identification badge containing customer identification information, and wherein said badge comprises a persistent memory module for storing said customer identification information [0020].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include that said

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identification is persistent as taught by Lefkowitz, because it would enhance the reliability of the system.

**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al.**

**Claim 6.** Zweben et al. teach said method and system, wherein the loyalty card (customer identification) is issued to the customer and which is used at the time of service request [0039].

However, Zweben et al. do not specifically teach that said loyalty card (customer identification) is issued with the service request.

Official notice is taken that it is well known that store loyalty cards or credit cards are offered to customers when the customers are shopping in the store.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include that said loyalty card (customer identification) is issued with the service request, because it would allow merchants to collect information about customer shopping activity so to provide said customers with targeted advertisement in future based on said collected information, thereby increase revenue.

**Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. in view of Saito et al. (US 2001/0014870).**

**Claim 10.** Zweben et al. teach said method and system, wherein the customer identification and the mobile device are issued to the customer [0039].

However, Zweben et al. do not specifically teach that said customer identification associates the mobile device with the customer.

Saito et al. teach a method and system for electronic coupon management using radio LAN, including a portable terminal carried around by a customer present at the store, wherein when the portable terminal (terminal ID) is properly registered, a user registration confirmation message is issued [0115]; [0093].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include that said customer identification associates the mobile device with the customer, as taught by Saito et al., because it would allow to use just one mobile device for a household, thereby reducing costs associated with the mobile device.

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**Claim 11.** Saito et al. teach said method and system, wherein the database stores the association between the mobile device and the customer [0115]; [0093].

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. and Saito et al.**

**Claim 12.** Zweben et al. and Saito et al. teach making the association between the mobile device and the customer upon issuing the mobile device to the customer (See **claim 10** and **claim 11**).

However, Zweben et al. and Saito et al. do not specifically teach breaking the association of the mobile device with the consumer upon return of the mobile device to the business.

Official notice is taken that it is well known in a communication service industry to retain a business equipment when a customer brakes a contract for said communication services.

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. and Saito et al. to include breaking the association of the mobile device with the consumer upon return of the mobile device to the business, because it would allow the business to use the same mobile device over and over again with new consumers, thereby saving funds.

**Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. in view of Godsey et al. (US 2002/0161651).**

**Claim 13.** Zweben et al. teach all the limitations of **claim 13**, except: tracking the customer within the store based on a position of the mobile device in relation to a plurality of beacons.

Godsey et al. teach a method and system for tracking consumers in a store environment, wherein said tracking is based on a position of a mobile device (battery powered RF or IR transmitter tag) in relation to a plurality of sensors [0019]; [0020].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include tracking the customer within the store, as taught by Godsey et al., because collected thereby information would allow merchants to better utilize a store floor space.

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**Claim 14.** Godsey et al. teach said method and system, wherein a server stores positions over time as position data [0023].

**Claim 15.** See claim 13 and claim 14.

**Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben et al. in view of Ambrose et al. (US 2002/0065879).**

**Claim 17.** Zweben et al. teach all the limitations of **claim 17**, except: delivering an acknowledgment to the mobile device confirming the receipt of the customer query.

Ambrose et al. teach a method and system for transferring service requests and responses to the requests between a client and an enterprise server, including acknowledging receipt of the service request [0339].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. to include acknowledging receipt of the customer query, as taught by Ambrose et al., because it would allow to improve the customer service, thereby make it more attractive to the customers.

**Claim 19.** See claim 17 and claim 1.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zweben and Ambrose et al. in view of Yacoby et al. (US 6,516,311).**

**Claim 18.** Zweben et al. and Ambrose et al. teach all the limitations of **claim 18**, except: parsing the customer query for at least one key word; and retrieving a response corresponding to the key word from a database.

Yacoby et al. teach a method and system for linking and directory assisting on the Internet, wherein a customer query is parsed for key words to retrieve matching information from a database ( column 5, lines 56-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zweben et al. and Ambrose et al. to include parsing the customer query for key words, as taught by Yacoby et al., because it would enhance the accuracy of matching the retrieved information to the consumer request.

### ***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

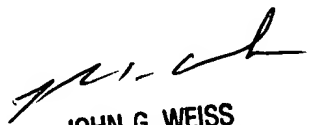
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or faxed to:

**(703) 872-9306** [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JB

  
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